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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,260	01/11/2002	David Emery Virag	PU 020010	7877

7590 11/26/2003

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EXAMINER

CHAN, WING F

ART UNIT	PAPER NUMBER
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2643

12

DATE MAILED: 11/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/044,260

Applicant(s)
Virag et al

Examiner
Wing Fu Chan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 27, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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1. This Office action is responsive to the amendment filed 10/27/03. As directed by the amendment, claim 10 was amended.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 10-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification is inadequately written to provide support for claims 10-13 in that the specification discloses two separate embodiments the first being the directory assistance embodiment and the second being a voice mail embodiment (see page 10 lines 12-32). There is no single integrated embodiment which discloses directory assistance service and voice mail service working together as one to provide both directory assistance and voice mail services as is claimed, therefore the specification is inadequately written to provide support for claims 10-13.

4. Claims 1-5, 8, 9, 14-19 are rejected under 35 U.S.C. 103(a) as being obvious over Sylvan (US PAT. NO. 5,457,738) in view of Gerszberg et al (US PAT. NO. 5,949,474 hereinafter Gerszberg).

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Sylvan discloses a telecommunication method and system comprising a telecommunication device (e.g. figure 1) having a display for viewing textual directory information, the device connected to a telephone network (not shown, e.g. see col. 3 line 52, col. 5 lines 16-17), a database application which includes directory information (e.g. see col. 5 lines 51-64), a mechanism (e.g. fig. 1, icons, see col. 4 lines 5+) coupled to the telecommunication device to provide the user with access when the mechanism is activated to provide directory information to the display of the telecommunication device in response to user entered text information (e.g. see all figures). Note entire patent. Sylvan differs from the claimed invention in not disclosing the telecommunication device being connected to a DSL telephone network.

However, it is old and well known in the art for telecommunication devices to connect to a DSL telephone network communication medium, for example see Gerszberg col. 3 line 52, col. 5 lines 16-17 which discloses a telecommunication method and system comprising a telecommunication device (e.g. figure 3A) having a display for viewing textual information, the device being connected to a DSL telephone network (e.g.) to access a database. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sylvan's the telecommunication device to connected to a DSL telephone network to access the remote database since it is old and well known in the art that DSL provides greater data transmission capacity and speed, e.g. provide faster access and data retrieval from the remote database.

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5. Claims 6, 7, 20, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sylvan as modified by Gerszberg as applied to claims 1-5, 8, 9, 14-19 above, and further in view of Desmond et al (US PAT. NO. 6,269,337 filed 7/1998 hereinafter Desmond).

Regarding claims 6, 20, Sylvan as modified by Gerszberg differs from the claimed invention in not disclosing the directory information includes business hours of an entry. However, it is notoriously old and well known in the art that a user of directory assistance services often wants to know additional information such as business hours, etc. (e.g. see Desmond col. 1 lines 33-38), and Desmond teaches a directory service which also provides the user with additional information associated with the entry such as business hours. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sylvan as modified by Gerszberg to provide additional information associated with the entry such as business hours to satisfy the needs of the user.

Regarding claims 7, 21, Desmond teaches that the listed (entry) party is charged a fee for this additional information service (e.g. col. 2 lines 15-20), this obviously is a priority, preference criteria as claimed since it is the preference, priority of the listed party to pay a fee to be listed in the same manner as disclosed by applicants.

6. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

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7. Applicant's arguments filed 10/27/03 have been fully considered but they are not persuasive.

Applicants' remarks regarding "priority listing" and "priority rating" is noted and is not persuasive. As defined in Webster's II New Riverside University Dictionary", a listing is 'a list', and rating is a position assigned to a scale, clearly the two are not the same as conceded by applicants as the term 'rating' is removed from claim 7.

Applicants' remarks regarding claims 10-13 have been fully considered but they are not persuasive. As clearly stated in the specification page 10 lines 12-20, for example, the voice mail and directory services are two different embodiments, there is no single integrated embodiment which discloses directory assistance service and voice mail service working together as one to provide both directory assistance and voice mail services as is claimed. The specification may provide ^{disclosure} ~~disclose~~ for both services, but there is no written disclosure that the two works together in a single embodiment, therefore contrary to applicants' erroneous allegations there is no written support for claims 10-13 as claimed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner W. F. Chan** whose telephone number is (703) 305-4732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached at (703) 305-4708. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read 'Wing F. Chan', is positioned above the printed name.

WING F. CHAN
SENIOR PRIMARY EXAMINER
TECHNOLOGY CENTER 2600

WFC
11/24/03